

JUL 26 2006 1:25PM
TO: USPTO

ZILKA-KOTAB, PC

NO. 3705 P. 1

ZILKA-KOTAB
PC
ZILKA, KOTAB & FEECE™

RECEIVED
CENTRAL FAX CENTER
JUL 26 2006

100 PARK CENTER PLAZA, SUITE 300
SAN JOSE, CA 95113

TELEPHONE (408) 971-2573
FAX (408) 971-4660

FAX COVER SHEET

Date: July 26, 2006	Phone Number	Fax Number
To: Examiner Serrou		(571) 273-8300
From: Kevin J. Zilka		

Docket No.: BVOC025

App. No: 10/078,188

Total Number of Pages Being Transmitted, Including Cover Sheet: 11

<p>Message:</p> <p>Please deliver to Examiner Serrou.</p> <p>Thank you,</p> <p>Kevin J. Zilka</p>

☐ Original to follow Via Regular Mail ☒ Original will Not be Sent ☐ Original will follow Via Overnight Courier

The information contained in this facsimile message is attorney privileged and confidential information intended only for the use of the individual or entity named above. If the reader of this message is not the intended recipient, you are hereby notified that any dissemination, distribution or copy of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by telephone (if long distance, please call collect) and return the original message to us at the above address via the U.S. Postal Service. Thank you.

IF YOU DO NOT RECEIVE ALL PAGES OR IF YOU ENCOUNTER
ANY OTHER DIFFICULTY, PLEASE PHONE April
AT (408) 971-2573 AT YOUR EARLIEST CONVENIENCE

July 26, 2006

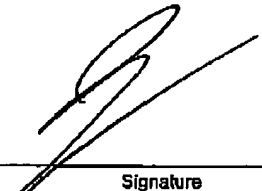
RECEIVED NO. 3705 P. 2
CENTRAL FAX CENTER
JUL 26 2006

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-000x
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		BVOC025	
I hereby certify that this correspondence is being facsimile transmitted to the Commissioner for Patents, Alexandria, VA 22313-1450 to fax number (571) 273-8300 on July 26, 2006.		Application Number	Filed
on July 26, 2006		10/078,188	02/15/2002
Signature <u>April Skovmand</u>		First Named Inventor	
Typed or printed name April Skovmand		Laura A. Werner	
		Art Unit	Examiner
		2626	Serrou, Abdelali
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/86)		Kevin D. Zilka	
<input checked="" type="checkbox"/> attorney or agent of record. 41,429		Typed or printed name	
Registration number		408-971-2573	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.		Telephone number	
Registration number if acting under 37 CFR 1.34		7/26/06	
		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> Total of 1 forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.5. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AP, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9198 and select option 2.

-1-

RECEIVED
CENTRAL FAX CENTER
JUL 26 2006REMARKS

The Examiner has rejected Claims 1-4, 9-10, 13-19, 21, and 23 under 35 U.S.C. 103(a) as being unpatentable over Valco et al. (U.S. Patent No. 6,826,264) in view of Ito et al. (U.S. Patent Application No. 09/839,309) in further view of Victor et al. (U.S. Patent No. 5,363,482) and in even further view of Hopper et al. (U.S. Patent No. 5,367,609). Applicant respectfully disagrees with such rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

With respect to the first element of the *prima facie* case of obviousness, the Examiner argues that it would have been obvious to have added the transition features of Victor et al. to the combined system of Valco et al. in order to provide a system that enabled the user to transit freely between states. Applicant respectfully disagrees with such assertion, especially in view of the vast amount of evidence to the contrary.

To the contrary, applicant respectfully asserts that it would not be obvious to combine the graphical transitions disclosed in Victor with the *non-analogous art* of Valco's method of interfacing a subscriber to a voice mail component of a telecommunications system, nor would it have been obvious to combine with Ito's voice browser apparatus.

For example, Valco relates to a voice mail interface, while Victor relates to a graphical transition in the context of a graphical interface. To simply glean a graphical transition of a graphical interface, such as that of Victor, and combine the same with the *non-analogous art* of voice mail

-2-

interfaces, such as that of Valco would simply be improper. Graphical user interfaces provide for graphical transitions, etc., while a voice mail interface provides an audible interface.

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) In view of the vastly different types of problems a graphical transition addresses as opposed to a voice mail interface, the Examiner's proposed combination is inappropriate.

More importantly, with respect to the third element of the *prima facie* case of obviousness, the Examiner has relied on Figure 2 in Valco to make a prior art showing of applicant's claimed "automatically tracking a plurality of states during the execution of the script utilizing the voice browser" (see the same or similar, but not necessarily identical language in the independent claims). Applicant notes, however, that such Figure only shows returning a user to a base state which is the message review area. Thus, tracking a plurality of states, in the manner claimed by applicant, is not only undisclosed in Valco, but would be useless in Valco since a user is always only capable of going back to the message review area.

In the Office Action mailed 03/27/2006, the Examiner argued that "applicant fails to show or to explain how Valco et al.'s manner of tracking a plurality of states [is] different from the manner claimed." However, applicant asserts that Figure 2 in Valco fails to disclose any tracking. Valco merely discloses that "[s]ome branching or "modality" (the condition of being constrained to the task at hand) cannot be eliminated," and that "[a]s seen in FIG. 2, which shows the primary modes of the current design, the user is immediately placed in message review" (Col. 6, lines 27-31). Valco continues, disclosing that "[f]rom message review the other major states are all available" (Col. 6, lines 31-32). Clearly, Figure 2 in Valco fails to disclose a technique of "automatically tracking a plurality of states during the execution of the script utilizing the voice browser" (emphasis added), as claimed by applicant. There simply is no disclosure in Figure 2 of Valco for "automatically tracking a plurality of states," as claimed by applicant.

-3-

In addition, the Examiner has relied on Col. 9, line 6 in Victor to make a prior art showing of applicant's claimed "determining whether code exists indicating a state other than the previous state to which the script should be transitioned in response to the request" (see the same or similar, but not necessarily identical language in the independent claims). Applicant respectfully asserts that Victor's button link commands, such as "Go To Slide n", merely relate to a transition to a slide. Thus, in Victor, a previous state that has been tracked is not transitioned to, in the manner claimed by applicant, but instead a new state is transitioned to where such new state is a specific slide. Even if the slide identified in Victor is a slide that was previously navigated to, Victor simply fails to teach that the transitioning to such slide is done utilizing tracked states, in the context claimed by applicant. Further, the claimed "determining whether code exists indicating a state other than the previous state to which the script should be transitioned in response to the request" (emphasis added) is simply not met.

In the Office Action mailed 03/27/2006, the Examiner argued that Victor teaches "transitioning to a previous state that has been transitioned to." Applicant asserts that the transition disclosed by Victor is merely "a special graphical effect ... that is displayed when the user moves from one slide to another in Run View." Clearly, a special graphic effect associated with a button link fails to even suggest a technique of "determining whether code exists indicating a state other than the previous state to which the script should be transitioned in response to the request" (emphasis added), as claimed by applicant. Again, Victor's disclosure that "[s]ome of the button link commands with which a [graphical] transition can be associated include, Go To Map or Go To Slide n, Previous, Next Topic, and Pop-up Go To" (emphasis added), fails to even suggest "indicating a state other than the previous state to which the script should be transitioned in response to the request" (emphasis added), as claimed by applicant.

Still with respect to the independent claims, the Examiner has relied on Col. 7, lines 7-9 from Hopper to make a prior art showing of applicant's claimed technique "wherein the script includes customizable forms and fields." Applicant respectfully asserts that, when read in context, such teaching does not meet applicant's specific claim language. In particular, Hopper discloses a "script [that] contains the list of actions to be performed" (see Col. 7, line 5). Thus, in Hopper only the list of actions may be customized. Applicant, on the other hand, claims a script with "customizable forms

-4-

and fields" (emphasis added), and not merely a customizable predetermined list of actions, as in Hopper.

In the Office Action mailed 03/27/2006, the Examiner argued that "Ho[p]per et al. teach[es] customizing a script that includes an action library (col. 7, line 7) that is customizable." Applicant asserts that Hopper teaches that "[t]he script contains the list of actions to be performed, such as play a prompt or receive digit, and the conditional sequencing of the actions in the list" (Col. 7, lines 5-7 - emphasis added). In addition, Hopper teaches that these actions in the script are customizable in that "[t]he action library resides in the ASI and the script, being customizable for each transaction and subscriber" (Col. 7, lines 7-9 - emphasis added). Clearly, a customizable action library fails to even suggest a script with "customizable forms and fields" (emphasis added), as claimed by applicant.

The Examiner has further relied on Col. 3, lines 16-17 in Valco to make a prior art showing of applicant's claimed technique "wherein the transitioning to the previous state is capable of being disabled according to at least one of an entire application, a document, a form and a field."

Applicant respectfully asserts that such excerpt merely teaches that "a third predetermined key (e.g. the star key) can cancel an action and immediately return the user to message view." Clearly, a key that a user can press to cancel an action, as in Valco, does not meet applicant's claimed disabling "the transitioning to the previous state." In fact, in Valco, only when a user is setting voice mail preferences can an action be cancelled, and then the user is subsequently returned to message review window. Thus, this *teaches away* from applicant's claim language since applicant claims disabling the transitioning to a previous state whereas Valco expressly discloses returning the user to a message review window.

In the Office Action mailed 03/27/2006, the Examiner argued that "transitioning to previous states is certainly an action and Valco et al. teach unquestionably canceling an action (col. 3, lines 16-17) that lead to "the transitioning to the previous state" (col. 4, lines 17-18 & Fig. 2)." Applicant asserts that Valco suggests that "a third predetermined key (e.g., the star key) can cancel an action and immediately return the user to message review" (emphasis added). Clearly, Valco's disclosure of using a star key to cancel an action and return the user to message review fails to even suggest a technique

-5-

"wherein the transitioning to the previous state is capable of being disabled according to at least one of an entire application, a document, a form and a field" (emphasis added), as claimed by applicant.

The Examiner seems to rely on Col. 3, lines 16-17, Col. 3, line 52, Col. 4, line 47 and Col. 4, lines 47-53 in Valco to make a prior art showing of applicant's claimed technique "wherein transitioning to the previous state retracts an input the user originally entered at the previous state." Applicant respectfully asserts that none of the excerpts relied on by the Examiner even suggest "transitioning to the previous state [which] retracts an input the user originally entered at the previous state," as claimed by applicant. In fact, Valco only teaches that a user can "cancel an action and immediately return the user to message review." Thus, in Valco the user is not returned to a previous state where input was originally entered since the user is only sent back to a message review, and therefore there is no input that can be retracted, in the manner claimed by applicant.

In the Office Action mailed 03/27/2006, the Examiner argued that "there are no further arguments beside the ones mentioned above with respect to the independent claims." However, applicant respectfully asserts that the excerpts from Valco simply fail to even suggest a technique "wherein transitioning to the previous state retracts an input the user originally entered at the previous state" (emphasis added), as claimed by applicant.

Applicant respectfully asserts that at least the first and third element of the *prima facie* case of obviousness have not been met, since it would be *unobvious* to combine the references, and the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above. A notice of allowance or a proper prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.